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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/340,739	06/28/1999	KIYONOBU KOJIMA	450100-4940	4288

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EXAMINER

WISDAHL, ERIC D

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 12/29/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/340,739

Applicant(s)

KOJIMA ET AL.

Examiner

Eric D Wisdahl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6,7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6,7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 14 November 2003 have been fully considered but they are not persuasive.

Applicant Argues:

1. Mitsuhashi discloses a method for (1) picking up an image, and (2) displaying the previously picked up image. Such a method does not correspond to the claimed invention of (1) starting up an application for picking up an image, and (2) picking up and storing said image.
2. Same as above but the claimed invention describes (1) starting up an application and displaying an image picked up upon the detection of the first operation, and (2) storing said still image that was displayed.
3. The examiner has not shown that the application program is booted when the first operation of the push button is detected.

Examiners Answers:

1. Mitsuhashi has not been relied upon for the functionality of the program relating to each of the two operations of the two-function push-button. Mitsuhashi was simply relied upon to show that it is known to have a single push-button, with three states (off, half-push and full-push), and that the operation of the system is different in each state. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references

individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

2. See above. Furthermore, this claim cannot be examined since it appears to be contradictory to itself, in that, the first and second operating states are as follows:

- Controlling means **activates a window** for said application program for picking up said image **when** said detecting means **detects said first operation**;
- The activated window for said application program displays said still image as **picked up** by said image pickup means **when said first operation is detected**;
- Controlling means **holds a still image picked up** by said image pickup means for preview in the activated window for said application program **while said first operation is performed**;
- Controlling means further causing said image pickup means to **pick up and store** said picked up image **when** said detecting means **detects said second operation**;
- Controlling means causes said still image pick-up means to **store said still image when said second operation is detected**.

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As such, it is unclear how the image is picked up and stored when the second operation is detected if the image has already been picked up, held and displayed when the first operation is detected.

3. Such a limitation was not previously explicitly stated. However, it is seen that such a limitation was implicitly contained and would still be rejected by the previous action, in that the system is reactionary to the user input, or changed system state, designated by the detecting system detecting the first operation. Namely, the system will detect the first operation, check to see if the application is already running and will either boot up the application (in response to the detected first operation and the system finding that such an application is not already started), or bring the application to the forefront of the display (if the application is already running when the first operation is detected).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10, 13 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains,

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or with which it is most nearly connected, to make and/or use the invention. See examiners answer 2, above, for explanation of contradictory limitations.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4, 6, 7, 9, 11 – 12, 14 – 15, and 17 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isashi (U.S. Patent 5, 898, 600) in view of Applicants admitted prior art in further view of Mitsuhashi et al. (U.S. Patent 6, 184, 930).

Regarding Claim 1, Isashi discloses an information processing apparatus capable of selecting and operating any of a plurality of application programs (Column 30 lines 59 – 62) including:

- an image pickup means (Column 30 lines 27 – 36);
- a detecting means for detecting user input (inherent Column 30 lines 63 – 66)
 - wherein the detecting means detects a first operation and a second operation performed by said user (inherent Column 16 lines 31 – 65,

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Column 25 lines 30 – 40, Column 30 lines 63 – 66 and Column 31 lines

14 – 23); and

- a control means for controlling an application program activated when the detecting means detects operations (Column 30 lines 63 – 66 and Column 31 lines 1 – 23);
 - wherein the control means, upon detecting a first operation, activates a window for an application program for picking up an image; and
 - wherein the control means, upon detecting a second operation, causes image pickup means to pick up said image (Column 16 lines 31 – 65, Column 25 lines 30 – 40, Column 30 lines 63 – 66 and Column 31 lines 14 – 23).

Isashi does not specifically disclose:

- Push Button;
- Information Processing Apparatus as having a GUI adopting windows;
- The detecting means having both the first and second operations performed by using the same push button.

Applicant's admitted prior art teaches:

- Information Processing Apparatus as having a GUI adopting windows;

According to Applicant's admitted prior art, such operating systems (i.e. Windows 95) are typical for use in a notebook or sub-notebook size personal computer to simplify operation of the computer.

Mitsubishi teaches:

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- A push button and the use of the half-push and full-push operation of said push button in order to facilitate two different operations performed by the camera using the same push button (Column 2 lines 33 – 43).

Such an arrangement is desirable in providing the user with ease of use in performing multiple functions.

Therefore, it would have been obvious for one of ordinary skill in the art to include the GUI adopting windows within the information processing apparatus and the detecting means having both the first and second operations performed by using the same push button in order to simplify the operation of the device.

Regarding Claim 3, Mitsuhashi teaches:

- The use of a half-push and full-push operation of a shutter button in order to facilitate two different operations performed by the camera using the same push button (Column 2 lines 33 – 43).

Such an arrangement is desirable in providing the user with ease of use in performing multiple functions.

Regarding Claim 4, see examiners notes Claim 1.

Regarding Claim 6, see examiners notes Claim 3.

Regarding Claim 7, see examiners notes for claim 1. Isashi does not disclose the storage medium for storing a program in a manner readable by an information processing apparatus. The

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storage medium is inherent in a system with a processor, in that a memory is needed to contain a program that controls the processor. Isashi discloses a system with a processor in Column 15 lines 17 – 26. It is noted that the CPU drives the components of the camera and facilitates the computations necessary to produce the images.

Regarding Claim 9, see examiners notes Claim 3.

Regarding Claim 11, Isashi discloses:

- **If** the application program for picking up said image **is not** active **when** said detecting means detects first operation:
 - **Before** said controlling means activates a window for said application program for picking up said image, said controlling means boots said application program (Column 16 lines 31 – 65, Column 25 lines 30 – 40, Column 30 lines 63 – 66 and Column 31 lines 14 – 23. It is seen that the controlling means places the display unit of the information processing apparatus as that of the conventional viewfinder of a camera when in a photographic mode. As such, the system either uses a window of an application previously in place or creates a new window any time that the system is placed in the photographic mode. Such an activation of the application, or boot, would necessarily take place before the activation of the window of the application if no such window exists, upon detecting the first operation).

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Regarding Claim 12, Isashi does not specifically disclose:

- Controlling means which begins storing a motion image picked up by said image pick up means **when** said detecting means detects a second operation and stops storing said motion image when said detecting means detects said second operation again.

Official Notice:

- Controlling means which begins storing a motion image picked up by said image pick up means **when** said detecting means detects a second operation and stops storing said motion image when said detecting means detects said second operation again.

Such an arrangement is well known in the art for the start and stop of recording motion images by the operation of a single button in multiple instances, each causing the opposite event from the previous instance of the button depression, in many conventional video cameras to obviate the need for multiple control buttons to perform the start and stop functions of recording. Such an operation is also known as toggling a control. (From Merriam-Webster's Collegiate Dictionary 10th Ed. Toggle: to switch between two options especially of an electronic device usually by pressing a single button or a simple key combination)

Regarding Claim 14, see examiners notes Claim 11.

Regarding Claim 15, see examiners notes Claim 12.

Regarding Claim 17, see examiners notes Claim 11.

Regarding Claim 18, see examiners notes Claim 12.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D Wisdahl whose telephone number is (703) 305-4915. The examiner can normally be reached on 9:00 - 5:00 Mon- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached on (703) 308-9644. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5399 for regular communications and (703) 308-5399 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology center 2600 customer service office which can be reached at telephone number (703) 306-0377.

EDW



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